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In re Application of
FINDLAY, John
Serial No.: 09/913,522
PCT No.: PCT/GB00/00517
Int. Filing Date: 17 February 2000
Priority Date: 18 February 1999
Atty. Docket No.: 9052.988
For: MODIFIED CALYCINS

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: DECISION ON PETITION
: UNDER 37 CFR 1.181
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This is a decision on applicants' "Petition to Withdraw Notification of Abandonment under 37 CFR 1.181(a) and Statement of Support" filed 09 May 2005 and applicant's unsigned facsimile communication dated 06 December 2005, which are being treated as petitions under 37 CFR 1.181.

BACKGROUND

On 17 February 2000, applicant filed international application no. PCT/GB00/00517 which claimed a priority date of 18 February 1999. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 24 August 2000. Pursuant to 37 CFR 1.495, the deadline for payment of the basic national fee in the United States was to expire 30 months from the priority date, 18 August 2001.

On 13 August 2001, applicant filed a transmittal for entry into the national stage in the United States, which accompanied by, inter alia: the requisite basic national fee as required by 35 U.S.C. 371(c)(1); a copy of the international application; and a preliminary amendment.

On 09 October 2001, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements (Form PCT/DO/EO/905) requiring an oath or declaration. The notification set a two-month time limit in which to respond.

On 10 December 2001, applicant filed an executed declaration.

On 28 January 2002, the United States Designated/Elected Office (DO/EO/US) mailed a "Notification of Acceptance of Application under 35 U.S.C. 371 AND 37 CFR 1.494 OR 1.495" (Form PCT/DO/EO/903) which set forth a 35 U.S.C. 371 completion date of 08 November 2001.

On 27 February 2002, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that the sequence listing was not in compliance with 37 CFR 1.821-1.825 in that a copy of the "sequence listing" in computer readable form has not been submitted as required by 37 CFR 1.821(e). Additionally, the United States Designated/Elected Office (DO/EO/US) mailed "Withdrawal of Previously Sent Notice" which indicated that the Notice (of Acceptance) mailed on 28 January 2002 was sent in error.

On 07 May 2002, applicant filed "Statement in Support of Filing a Sequence Listing under 37 CFR 1.821(f)" which included a Statement under 37 CFR 1.821(e) with a hard copy and a computer readable form of the sequence listing.

On 30 July 2002, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Defective Response (Form PCT/DO/EO/916) indicating that the "nucleotide and/or amino acid sequence disclosure contained in this application does not comply with the requirements for such a disclosure as set forth in 37 CFR 1.821-1.825 for the following reasons: A computer readable that has been filed with this application has been found to be damaged and/or unreadable as indicated on the attached CRF Diskette Problem Report. A substitute computer readable form must be submitted as required by 37 CFR 1.825(d)."

On 12 August 2002, applicant filed "Statement in Support of Filing a Substitute Sequence Listing under 37 CFR 1.821(f)" which included a Statement under 37 CFR 1.821(e) with a hard copy and a computer readable form of the sequence listing.

On 17 October 2002, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Defective Response (Form PCT/DO/EO/916) indicating that the nucleotide and/or amino acid sequence disclosure contained in this application does not comply with the requirements for such a disclosure as set forth in 37 CFR 1.821-1.825.¹

On 28 October 2002, applicant filed "Statement in Support of Filing a Substitute Sequence Listing under 37 CFR 1.821(f)" which included a Statement under 37 CFR 1.821(e) with a hard copy and a computer readable form of the sequence listing.

On 22 June 2004, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Defective Response (Form PCT/DO/EO/916) indicating that the "nucleotide and/or amino acid sequence disclosure contained in this application does not comply with the requirements for such a disclosure as set forth in 37 CFR 1.821-1.825 for the following reasons: A computer readable that has been filed with this application has been found to be damaged and/or unreadable as indicated on the attached CRF Diskette Problem Report. A substitute computer readable form must be submitted as required by 37 CFR 1.825(d)."

¹The United States Designated/Elected Office should have mailed a Notification of Abandonment (Form/DO/EO/903) indicating that the application was abandoned for failure to file a complete response to the Notification of Missing Requirements mailed 27 February 2002 since the time period to respond had expired.

On 21 July 2004, applicant filed "Response under 37 CFR 1.825(d) and Statement in Support of Filing a Substitute Sequence Listing under 37 CFR 1.821(f) which included a Statement under 37 CFR 1.821(e) with a hard copy and a computer readable form of the sequence listing.

On 30 July 2004, the PALM Database indicated that a compliant computer readable form (CRF) had been submitted.

On 05 April 2005, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Abandonment (Form PCT/DO/EO/909) indicating that the application was abandoned for failure to file a complete response to the Notification of Missing Requirements mailed 27 February 2002 within the time period set therein.

On 09 May 2005, applicant filed the present petition to withdraw holding of abandonment.

DISCUSSION

The above-identified application was abandoned for failure to file a complete response to the Notification of Missing Requirements mailed 27 February 2002, in that, the sequence listing in computer readable form had not been submitted within the period set therein. Applicant states in their present petition that each paper issued by the USPTO was replied to within the time period set. Further, applicant contends that "each action taken by the Petitioner was a bona fide attempt to respond to the communication received from the USPTO." 37 CFR 1.136(a) states, in part, "[i]f an applicant is required to reply within a nonstatutory or shortened statutory time period, applicant may extend the time period for reply up to the earlier of the expiration of any maximum period set by statute or five months after the time period set for reply" In this case, the Notification of Missing Requirements was mailed on 27 February 2002, therefore, applicants were required to submit a response by 27 April 2002. If applicant elected to use to the provisions under 37 CFR 1.136, applicants would be required to file a complete response by 27 September 2002. Therefore, the mailing of the Notification of Defective Response dated 17 October 2002 was mailed in error and the application was abandoned. (See footnote 1 of page 2) Further, the computer readable forms submitted on 07 May 2002, 17 August 2002 and 28 October 2002 were not in compliance with 37 CFR 1.821-1.825, in that, the computer readable forms were damaged and/or unreadable.

Therefore, applicants have not provided the proper showing necessary to withdraw the holding of abandonment and the petition may not be properly granted.

CONCLUSION

The petition under 37 CFR 1.181 is **DISMISSED** without prejudice and the application remains **ABANDONED**.

Applicants may wish to consider filing a petition to the Commissioner under 37 CFR 1.137(a) or (b) requesting that the application be revived. Any petition filed under 37 CFR

1.137(a) and/or a petition under 37 CFR 1.137(b) requesting that the application be revived must meet the criteria indicated in the recent revision of 37 CFR 1.137. This recommendation to file a petition under 37 CFR 1.137(a) or (b) should not be construed as an indication as to whether or not any such petition(s) will be favorably considered.

If reconsideration on the merits of this petition is desired, an appropriate response to this decision must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.181."

Any further correspondence with respect to this matter deposited with the United States Postal Service should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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